

Claim 21 (new) - The method of claim 20 wherein said reorienting step includes selecting from a plurality of second outcomes such that said selected second outcome represents a maximum award when compared with alternative second outcomes.

pls Sub B7
Claim 22 (new) - A method of gaming, the steps including:

enabling a gaming device;
generating a first outcome;
comparing said first outcome to a payable;
awarding credits if said first outcome is present on said payable;
manipulating said first outcome according to a rule set if and only if said first outcome is not present on said payable, and if and only if said second outcome is present on said payable; and
awarding credits if said second outcome is present on said payable.

REMARKS

The Office Action dated May 16, 2002 has been received, its contents carefully noted, and the applied citations thoroughly studied. Accordingly, the foregoing revisions to the specification and claims are tendered with the conviction that patentable contrast has now been made manifest over the known prior art and certain typographical inexactitudes have been rectified to provide better form. Accordingly, all rejections tendered by the Examiner in the above-referenced Office Action are hereby respectfully traversed and reconsideration is respectfully requested.

It is believed that the foregoing revisions to the claims are within the metes and bounds of the recently articulated Supreme Court *Festo* case, in that all equivalents

susceptible to capture have been retained in that one skilled in the art, at the time of this amendment, could not have reasonably be expected to have drafted a claim that would have literally encompassed any other equivalent.

Rejections under 35 U.S.C. § 102

With respect to rejections under 35 U.S.C. § 102, the Examiner is invited to consider the following binding, compelling precedent articulated by the Court of Appeals for the Federal Circuit:

“. . . anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference.” *Akzo N.V. v. United States ITC*, 808 F.2d 1471, 1 U.S.P.Q.2d 1241 (Fed. Cir. 1986).

Further, “those elements must either be inherent or disclosed expressly . . .” *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987). “. . . and must be arranged as in the claim[s] . . .” *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, 231 U.S.P.Q. 644 (Fed. Cir. 1986).

In addition, “. . . [the] absence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986).

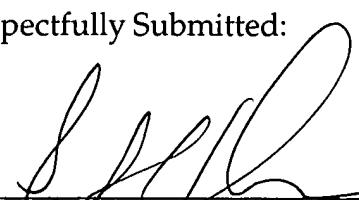
The Examiner has rejected claims 1 through 16 under 35 U.S.C. § 102(b) as being anticipated by Bessho ‘169. Undersigned respectfully submits that the symbol-moving features of the instant invention are enabled only if the initial outcome is not recognized by the payable. If the initial outcome is recognized by the payable, the player is awarded and the game ends. If, and only if, the initial outcome is not present on the

paytable, then the visible symbols are compared to the paytable according to a rule set. Bessho's specific condition detecting circuit (47) is always active after the reels (5 to 9) stop moving (col. 3, lines 51-58), so the output is only checked against the paytable once. By contrast, an additional condition is present in the present invention. Claims 1, 7, 10, 11, 15, and 16 have been amended to make this distinction explicit, namely, that the output is first examined for its presence on the paytable, and if there is no match, another comparison takes place and the movable output features of the instant invention are engaged. If there is an initial match on the paytable, the player is awarded and the game ends.

In view of the foregoing, it is respectfully requested that the Examiner pass this case to issue. If, upon further consideration, the Examiner believes further issues remain outstanding or new ones have been generated, undersigned respectfully requests that the Examiner call undersigned to expeditiously resolve same.

Dated: August 12, 2002

Respectfully Submitted:



BERNHARD KRETEN
Applicant's Attorney
Telephone (916) 930-9700
Registration No.: 27,037